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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/609,438      | 07/01/2003  | Je-Chang Jeong       | Q75265              | 7906             |

23373 7590 02/22/2006

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| EXAMINER |
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LE, VU

|          |              |
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| ART UNIT | PAPER NUMBER |
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2613

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/609,438 | <b>Applicant(s)</b><br>JEONG ET AL. |  |
|                              | <b>Examiner</b><br>Vu Le             | <b>Art Unit</b><br>2613             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16,32-35,37-39,48-51,53-55 and 65-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☒ Claim(s) 16,32-35,37-39,48-51,53-55 and 65-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Response to Amendment/Arguments***

1. The amendment filed 02 September 2005 overcomes the following rejection(s):

a. Provisional double patenting rejection of claims 65-67, 69-71 in view of claims 19-21, 23-25 of copending application 10/612,013. *(Claims 19-21, 23-25 of copending application 10/612,013 were canceled by amendment)*

b. Provisional double patenting rejection of claim 16 in view of claim 10 of copending application 10/612,013. *(Claim 10 of copending application 10/612,013 was amended to add further limitations that differentiate in scope with that of claim 16. Note however that amended claim 10 of '013 contains new matter issue that has yet to be resolved)*

2. The amendment fails to address pending rejections of claims 32-35, 37-39 and claims 48-51, 53-55 in view of copending application 10/612,013 and of US patent 6,680,975 respectively. The failure to address the rejections will be interpreted as acquiescing to the rejections.

3. With respect to the rejection of claims 65-71 in view of claims 26-32 of US patent 6,680,975, Applicant contends that claim 26 of '975 recites "a decoding means wherein the selected scanning pattern produces the most efficient coding according to a predetermined criterion" whereas independent claim 65 does not. Applicant further contends that since Examiner reasoned in the Supplemental OA of May 02, 2005 that states 'typically, the scanning pattern that produces the best efficiency is selected, therefore, "it would not be obvious to one skilled in the art to not have a selected

scanning pattern which produces the most efficient coding according to a predetermined criterion" (Remarks, p. 13). The arguments are not persuasive.

Claim 65 does not positively claim the assertion that "it would not be obvious to one skilled in the art to not have a selected scanning pattern which produces the most efficient coding according to a predetermined criterion". And even if such features are ultimately claimed, they will raise the issue of new matter since the specification as originally filed does not provide support for them.

As reasoned in the last OA of May 02, 2005, claim 65 recites, inter alia, one of the scanning patterns is being selected. Typically, the scanning pattern that produces the best efficiency is selected. This is obvious to one skilled in the art.

The argument for claim 16 is identical to claim 65. Hence, Examiner's position is the same as explained above.

#### ***Status of Claims***

4. Claims 1-16, 32-35, 37-39, 48-51, 53-55, 65-71 are pending.
5. Claims 1-15 are allowed as previously indicated.
6. Claims 36, 52, 56 were canceled by Preliminary Amendment of September 14, 2004.
7. Claims 17-31, 40-47, 57-64, 72-95 were canceled by Amendment of September 2, 2005.

#### ***Non-Statutory***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 32-35, 37-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26-29, 31-33 of copending Application No. 10/612,013 for the same reasons as stated in the last Office Action.

10. Claims 48-51, 53-55 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 42-45, 47-49 of copending Application No. 10/612,013 for the same reasons as stated in the last Office Action.

11. Claims 65-71 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26-32 of U.S. Patent No. 6,680,975 for the same reasons as stated in the last Office Action.

12. Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,680,975 for the same reasons as stated in the last Office Action.

13. Claims 32-35, 37-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33-36, 38-39 of U.S. Patent No. 6,680,975 for same reasons as stated in the last Office Action.

14. Claims 48-51, 53-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 56-59, 61-63 of U.S. Patent No. 6,680,975 for the same reasons as stated in the last Office Action.

### ***Conclusion***

**15. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Contact**

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu Le whose telephone number is (571) 272-7332. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. Customer Service can be reached at (571) 272-2600. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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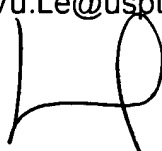
*Vu Le*

*Primary Examiner*

AU 2613

(571) 272-7332

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A handwritten signature in black ink, appearing to be 'Vu Le', with a stylized, cursive-like structure.